

BS01372

U.S. Application No. 10/017,111 Examiner ALVAREZ, Art Unit 3622
Response to July 12, 2005 Office Action

REMARKS

In response to the Office Action dated July 12, 2005, the Assignee respectfully requests reconsideration based on the above amendments and based on the following remarks. The Assignee respectfully submits that the pending claims distinguish over the cited document to *Knudson*.

The United States Patent and Trademark Office (the "Office") again rejects claims 1-4, 6-15, and 18-38 under 35 U.S.C. § 103 (a) as being obvious over WO 99/45702 to Knudsen. The Assignee must respectfully disagree and, instead, strongly assert that the pending claims are patentably distinguishable over *Knudson*.

Rejection of Claims under 35 U.S.C. § 103 (a)

The Office again rejects claims 1-4, 6-15, and 18-38 under 35 U.S.C. § 103 (a) as being obvious over WO 99/45702 to Knudsen. If the Office wishes to establish a *prima facie* case of obviousness, three criteria must be met: 1) combining prior art requires "some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill"; 2) there must be a reasonable expectation of success; and 3) all the claimed limitations must be taught or suggested by the prior art. DEPARTMENT OF COMMERCE, MANUAL OF PATENT EXAMINING PROCEDURE, § 2143 (orig. 8th Edition) (hereinafter "M.P.E.P."). As the Assignee shows, however, *Knudson* does not teach or suggest all the features of the independent claims, so one of ordinary skill in the art would not think the claims obvious. The Assignee again respectfully requests Examiner Alvarez to remove the § 103 (a) rejection of the claims.

Independent claims 1, 15, and 38 are not obvious in view of *Knudson*. All the independent claims recite features for "*receiving the user's credit card purchase records describing purchases from retail stores.*" Moreover, all the independent claims also recite features for "*classifying the user in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores.*" A "clean" version of amended,

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independent claim 1 is reproduced below, and independent claims 15 and 38 recite similar features.

1. A method for marketing, comprising:

defining a match between a user classification and an incentive;
receiving from a set-top box user data associated with a user's television viewing selections;
receiving the user's credit card purchase records describing purchases from retail stores;
classifying the user in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores; and
transmitting the incentive to the user if a match is defined between the user classification and the incentive.

The *Knudson* document completely fails to teach or suggest such features. As the Assignee previously noted, Examiner Alvarez is correct in recognizing that *Knudsen* receives "information regarding programs that have been purchased and viewed." *Knudsen* at page 10, lines 8-11. *Knudsen* also describes an "order processing and billing system" for pay-per-view programming. *Knudsen* at page 9, lines 5-8. *Knudsen*, however, fails to realize that users can be classified according to "*purchases from the retail stores*." The independent claims all recite features for "*receiving the user's credit card purchase records describing purchases from retail stores*" and for "*classifying the user in a user classification when the user's television viewing selections relate to the user's purchases from the retail stores*." *Knudson* is completely silent to such features.

The Assignee must strongly, yet respectfully, disagree with Examiner Alvarez. Examiner Alvarez, in the July 12, 2005 office action, asserts that such claimed features are obvious in view of *Knudson*. The Assignee and Examiner Alvarez both agree that *Knudson* teaches targeting incentives to viewers based on pay-per-view purchases. See, e.g., *Knudsen* at page 10, lines 8-11. Examiner Alvarez, however, takes "Official Notice" that credit cards are a well known method of making purchases. See Examiner Alvarez, July 12, 2005 office action, at page 7, lines

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8-11. Examiner Alvarez also takes “Official Notice” that monitoring purchases at retail establishments is a well known method of tracking customer purchases. *See id.* at lines 11-13. Examiner Alvarez then asserts that it would have been obvious to modify *Knudson* to include credit card purchases at made at retail establishments. *See id.* at lines 13-18.

The Assignee strongly and, yet, respectfully, disagrees. Whether or not credit card purchases are well-known, and whether or not monitoring purchases at retail establishments is well known, Examiner Alvarez’s conclusion is faulty. Examiner Alvarez must cite documents in an analogous field that relate credit card purchase records to television viewing selections. Or, using the pending claim language, Examiner Alvarez must find analogous documents that “*receiv[e] the user’s credit card purchase records describing purchases from retail stores*” and “[*classify]* the user in a user classification when the user’s television viewing selections relate to the user’s purchases from the retail stores.” The *Knudson* document targets incentives to viewers based on pay-per-view purchases. *Knudson*, however, makes no teaching or suggestion that relates “*the user’s television viewing selections ... to the user’s purchases from the retail stores,*” as the independent claims recite. So, whether or not Examiner Alvarez’s assertions of “Official Notice” are accurate, the teachings of *Knudson* do not support her obviousness conclusion. *Knudson* is completely silent to any relation between television viewing selections and purchases from retail stores, so one of ordinary skill in the art would not think the claims obvious, despite Examiner Alvarez’s “Official Notice.”

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 387-6907 or scott@wzpatents.com.

Respectfully submitted,



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